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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/698,800 | 10/27/2000 | Kenneth Snowden | 476-1951 | 5134 |

7590 08/21/2003

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EXAMINER

HOFFMANN, JOHN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1731

DATE MAILED: 08/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|--------------------------------|--|
| Office Action Summary | Application No. 09/698,800 | Applicant(s) SNOWDON ET AL. | |
| | Examiner John Hoffmann | Art Unit 1731 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6-10-09-03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 7-9, 28+31-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 5, 7-9 is/are allowed.
- 6) ☒ Claim(s) 28, 31-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

Claims 28, 31-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "induced current flow bond" is indefinite as to its meaning. There is no disclosure of such a bond and it is unclear what it requires. Examiner could find no discussion of this term in the prior art. Examiner's experience is that a bond created from induced current would be indistinguishable from those made by any other heat source, and thus it is deemed that one of ordinary skill would not know what type of bond this is.

Furthermore, it is unclear if the glass is melted by using 5% inductive heat and 95% flame heat. Is this considered to be an "induced current flow bond"? One of ordinary skill would not be able to determine whether or not he is infringing simply by using 90% inductive heat and 10% radiative heat. The claim fails to adequately inform one of ordinary skill if he is infringing.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 28, 31-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support for any "induced current flow bond".

Claim Rejections - 35 USC § 102

Claims 28, 31, 32 and 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Kramer 5143531.

Examiner's dictionary has the following definitions for bond: "an adhesive, cementing material, or fusible ingredient that combines, unites or strengthens" and "a uniting or binding element or force" and "a material or device for binding". Going by these definitions, a bond does not include the two things which are united by the bond.

"...patentability of a claim to a product does not rest merely on a difference in the method by which that product is made. Rather it is the product itself which must be new and unobvious" (In re Pilkington, 162 USPQ 147). Presently the limitations as to how the bond is formed, do not import any structural limitation into the claims. By looking at the Kramer product, one cannot ascertain as to the heat source used to melt it. Any structural difference would be a result in how the glass cooled.

Claims 31-32. The specification and claims do not give any indication as to which characteristics the claims are referring to. One characteristic of all ferromagnetic materials and ferromagnetic materials have is that they are made of atoms. The Kramer element is also made of atoms.

Alternatively, it is noted that there is no indication that the claim is directed to something that comprises a combination of a bond, a fiber and a metallic element. The "between language only specifies where it was made. It could be made in Chicago, or under a bridge or between a fiber and a metallic element. For example the claim language is so broad the fiber could be 20 feet from the element and while bond is created between those two things (the bond uniting two other elements). Where the bond is created has essentially no weight because it is only the bond itself which must be new and unobvious.

Alternatively, the bond could be formed so that it unites two fibers and two metallic elements - and then one fiber and one metallic element are removed. It would be improper for the Office to impute limitations (i.e. that a fiber and a metallic element are required by the product) into the claims. THUS, one looking at the Kramer bond, one would have no way of telling if it was created between a fiber and a metallic element with a glass fixative.

These two "alternatives" also apply to claim 28.

Claim 37: See Kramer, col. 1, line 50.

Claim 38 is clearly met..

Claims 28, 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Letter 3421915.

See how Letter is applied in the previous Office action. Also, as indicated above, see how the claims do not require any fiber or metal object.

Claim Rejections - 35 USC § 103

Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of Letter.

Kramer does not disclose the type of glass used. Letter discloses the Letter glass creates a "strong" bond. It would have been obvious to use the letter glass because such will create a "strong" bond and one would want a strong bond to ensure that the device does not come apart.

Allowable Subject Matter

Claim 36 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 1, 5, 7-9 are allowed.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

It is argued that claim 28 has been amended "... so as to direct the claims to an method". Claim 28 is clearly directed to a bond, not to a method.

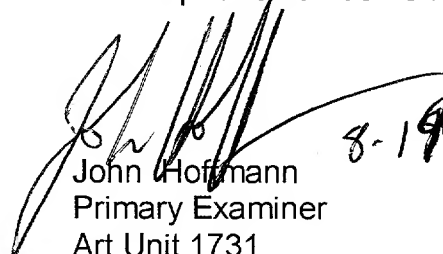
It is further argued that claim 28 defines the glass material bond to be an "induced current flow bond". Examiner does not see how this is relevant. Applicant has not demonstrated that using inductive heating would create a bond that is any different than one that was created by other heating methods.

IT is argued that claim 28 incorporates the features of claim 4 and thus is allowable. Claim 4 was directed to a method, but claim 28 is directed to a product. IT is the product limitations that must be new and unobvious. An old product can be made by a new and unobvious method. Therefore, Applicant's new method doesn't automatically imply a new product.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is 703-308-0469. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 703-308-1164. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


John Hoffmann
Primary Examiner
Art Unit 1731
8-19-03

jmh